UNITED STATES PATENT AND TRADEMARK OFFICE

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| 10/535,318 | 12/06/2005 | Guoshun Deng | B-5720PCT 622686-6 | 5692 |

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LADAS & PARRY
5670 WILSHIRE BOULEVARD, SUITE 2100
LOS ANGELES, CA 90036-5679

| EXAMINER |
|---|
| AJIBADE AKONAI, OLUMIDE |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2617 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/535,318 | DENG ET AL. |
| | Examiner | Art Unit | |
| | OLUMIDE T. AJIBADE AKONAI | 2617 | |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on <u>30 December 2008</u>.

2a) ☐ This action is **FINAL**.  2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) <u>1-9</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-9</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All  b) ☐ Some * c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1.    A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 30, 2008 has been entered.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2.    Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 1, the applicant discloses the limitation "wherein the operating system limits sending said commands to the removable storage device, said commands include a device control operation command corresponding to an operation that the operating system limits the removable storage device from performing". The applicants' representative points to page 6, lines 1-2, and page 10, lines 16-26, of the specification as providing support for this limitation. However, it is not

clear to the examiner as to how this pages and lines in the specification support this limitation in claim 1, or if they support this limitation at all. The examiner interprets page 6, lines 1-2 of the specification as the host system 20 connecting to the mobile storage device 10 via a universal interface so that the user can perform data read or write operations to the mobile storage device 10 via the host system 20. The examiner interprets page 10, lines 16-26 of the specification as sending device control operation command to the mobile storage device 10, while the host system with Windows OS is under the non-administrator mode. In the non-administrator mode, the user can only send read file commands or write file commands. The descriptions of the pages and lines above fail to clearly disclose or suggest "**wherein the operating system limits sending said commands to the removable storage device, said commands include a device control operation command corresponding to an operation that the operating system limits the removable storage device from performing**". This limitation is not adequately supported by the specification and constitutes new matter. The examiner respectfully requests that the applicants provide page(s), line(s), and figure(s) of the instant application that supports this limitation of the claim. For the purpose of examining the application, the examiner takes the limitation "**wherein the operating system limits sending said commands to the removable storage device, said commands include a device control operation command corresponding to an operation that the operating system limits the removable storage device from performing**" to mean that the operating system is providing device control commands to the removable storage device so that the removable storage device is capable of

performing an operation that it was previously unable to perform without the device

control operation command corresponding the operation.

### Response to Arguments

3.      Applicant's arguments with respect to claim 1 have been considered but are moot

in view of the new ground(s) of rejection.

### Claim Rejections - 35 USC § 103

4.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.      Determining the scope and contents of the prior art.
2.      Ascertaining the differences between the prior art and the claims at issue.
3.      Resolving the level of ordinary skill in the pertinent art.
4.      Considering objective evidence present in the application indicating
obviousness or nonobviousness.

This application currently names joint inventors.  In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary.  Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

1.      Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over

**Niiyama et al 5,400,389 (hereinafter Niiyama)** in view of **Ritter 6,859,650** and

**Nishimura 6,934,537**.

Regarding **claim 1**, Niiyama discloses a method for sending commands and/or

data to a storage device (portable telephone 10 comprising flash memory 202, see fig.

1, col. 3, lines 60-62), comprising configuration of an application running in an operating

system (ROM write unit 5, see fig. 3, col. 5, lines 41-45), said application being used to

send the commands and/or data to the storage device, wherein the operating system

limits sending said commands to the storage device, said commands include a device

control operation command corresponding to an operation that the operating system

limits the storage device from performing (ROM writer 5 rewriting the operation program

stored in the flash memory of portable terminal 10 so that the portable telephone 10 is

able change and perform a different function, indicating portable telephone 10 is limited

in the its functions/operation, and the program that is rewritten to the flash memory 202

of the portable terminal changes the function/operation, see abstract, col. 5, lines 41-

61), and the method further comprising the following steps: 1) said application setting an

identification mark (code data indicating byte mode instruction or page mode instruction,

see fig. 8, col. 7, lines 34-55) for the commands and/or data (code data for inputting

data into memory, see fig. 8, col. 7, lines 53-66), said identification mark and the

commands and/or data forming a data packet (instruction command sent from ROM

writer 5 to portable telephone comprising flash memory 202 includes code data to indicate byte or page mode instruction and instruction command or data, see col. 7, lines 34-55); 2) said application sending to the storage device through the operating system the data packet together with a write command according to the standard write command format provided by the operating system (transmitting code data for writing to flash memory, see figs. 1, 3 and 7, col. 7, lines 53-66, col. 9, lines 22-25, col. 10, lines 21-34); 3) said storage device receiving from the operating system the write command and the data packet (see col. 10, lines 21-52); 4) said storage device interpreting and obtaining the commands and/or data in the data packet based on the identification mark (see col. 7, lines 34-43, col. 8, lines 45-52, see col. 1, lines 27-29) and 5) said storage device performing the corresponding operation according to the commands and/or data (program in the rewritable memory, flash memory 202 of the portable telephone 10 is rewritten in order to change the function of the portable telephone, see col. 7, lines 34-43, col. 8, lines 45-52, see col. 1, lines 27-29), and sending to said application the operation result via the operating system (sending an acknowledgement, see col. 8, lines 55-60).

Niiyama does not specifically disclose that the storage device is a removable storage device.

In the same field of endeavor, Ritter discloses a portable device (see fig. 1, col. 3, lines 40-46) comprising a removable flash memory SIM card (SIM card 2 comprising microcontroller 20, in which data can be read and written into, see abstract, fig. 1, col. 3, lines 49-62, and col. 4, lines 20-38).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Ritter, by having the flash memory of Niiyama as a removable flash memory card, into the portable telephone of Niiyama for the benefit of transferring the SIM card from one or the portable apparatus to another.

Niiyama as modified by Ritter does not specifically disclose said removable storage device being connected with said operating system via a universal interface.

In the same field of endeavor, Nishimura discloses a PC (PC 13, see figs. 4 and 7, col. 9, lines 64-65) connected to a cellular phone unit with a storage device (cellular phone unit 10, see figs. 4 and 7, col. 9, lines 64-65), wherein the PC is connected to storage device of the cellular phone unit via a USB connection (see figs. 4 and 7, col. 9, lines 64-65, and col. 10, lines 10-13, 34-61).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Nishimura, by connecting a PC to a storage device in a cellular phone using a USB interface, into the system of Niiyama as modified by Ritter, for the benefit of rewriting a program that is in the memory device of a portable device.

Regarding **claim 2**, as applied to claim 1, Niiyama further discloses wherein the standard write command format is the standard write file function command format provided by the operating system (rewriting program to flash memory of the portable telephone, see col. 10, lines 31-52).

Regarding **claim 3**, as applied to claim 1, Niiyama further discloses wherein the command and/or data in the data packet comprise, but not limit to, the device control operation command of the mobile storage device (program in the rewritable memory of the portable telephone 10 is rewritten in order to change the function of the portable telephone, see col. 7, lines 34-43, col. 8, lines 45-52, see col. 1, lines 27-29).

Regarding **claim 4** as applied to claim 1, Niiyama further discloses wherein the application can also send the commands and/or data under a non-administrator mode of said operating system (rewriting program to flash memory of the portable telephone, see col. 10, lines 31-52).

Regarding **claim 5** as applied to claim 1, Niiyama further discloses wherein the mobile storage device comprises, but not limit to USB flash disk, mobile hard disk, semiconductor mobile storage device, MO disk, ZIP disk, and mobile phone (see fig. 1, lines 26-27).

Regarding **claim 6** as applied to claim 1, Niiyama further discloses wherein the commands and/or data can be either user-defined command and/or data, or the standard operation commands and/or data (see col. 10, lines 31-52).

Regarding **claim 7** as applied to claim 6, Niiyama further discloses wherein the commands and/or data in the data packet comprise, but not limit to, the password verification command, password modification command, storage capacity obtaining command, device internal information obtaining command, write protect setting command, write protect determining command, switching state determining command, device internal information modification command, data position obtaining command,

storage disk switching command, formatting command and storage capacity altering

command (program in the rewritable memory of the portable telephone 10 is rewritten in

order to change the function of the portable telephone, see col. 7, lines 34-43, col. 8,

lines 45-52, see col. 1, lines 27-29).

2.       Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

**Niiyama et al 5,400,389 (hereinafter Niiyama)** in view of **Ritter 6,859,650** and

**Nishimura 6,934,537** as applied to claim 6 above, and further in view of **Terho et al**

**5,884,103 (hereinafter Terho)**.

Regarding **claim 8**, as applied to claim 6, Niiyama as modified by Ritter and

Nishimura discloses the claimed limitation except wherein the operating system refers

to Windows operating system of Microsoft Inc., comprising, but not limits to, Windows

98, Windows Me, Windows 2000 Professional, Windows 2000 Server, Windows 2000

Advance Server, Windows XP Professional, Windows XP Home Edition Windows XP

Server, Windows XP Advance Server, and subsequent operating systems developed by

Microsoft Inc.

In a similar field of endeavor, Terho discloses an application (see figs. 6

and 8, col. 4, lines 48-56) comprising an operating system (see col. 8, lines 62-67, col.

9, lines 1-2) except wherein the operating system refers to Windows operating system

of Microsoft Inc., comprising, but not limits to, Windows 98, Windows Me, Windows

2000 Professional, Windows 2000 Server, Windows 2000 Advance Server, Windows

XP Professional, Windows XP Home Edition Windows XP Server, Windows XP

Advance Server, and subsequent operating systems developed by Microsoft Inc (see col. 8, lines 62-67, col. 9, lines 1-2).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Terho, by having a PC/device transmitting messages to control a mobile device have a windows operating system, into the system of Niiyama as modified by Ritter and Nishimura for the benefit of enabling proper transfer of data between a PC or controlling device and a mobile device by using a flexible and standard operating system.

Regarding **claim 9**, as applied to claim 1, Niiyama as modified by Ritter and Nishimura discloses the claimed limitation except wherein the application can send the commands and/or data under the non-administrator mode of Windows operating system of Microsoft Inc. Terho, however further discloses wherein the application can send the commands and/or data under the non-administrator mode of Windows operating system of Microsoft Inc (see col. 8, lines 62-67, col. 9, lines 1-2).

### *Conclusion*

3.     The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Deo et al 6,832,084 discloses wireless database environment.

Oba 6,745,278 discloses computer capable of rewriting an area of a non-volatile memory with a boot program during self mode operation of the computer.

Hasbun 6,205,548 discloses methods and apparatus for updating a non-volatile memory.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLUMIDE T. AJIBADE AKONAI whose telephone number is (571)272-6496. The examiner can normally be reached on M-F, 8.30p-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


OA

/Charles N.  Appiah/
Supervisory Patent Examiner, Art Unit 2617